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a transmitter configured to transmit data to the telephone terminal at one of the first speed and the second speed;

a receiver configured to receive data from the telephone terminal at one of the first speed and the second speed;

a detector configured to detect whether or not the telephone terminal is capable of transmitting and receiving data at the second speed; and

a mode setting device configured to set an operation speed of said transmitter and said receiver to an optimum speed based on the detection result of said detector.

REMARKS

By this Amendment, Applicant amends claims 1, 5, 10, and 12 for purposes of clarity and without changing the scope thereof, nor for reasons of patentability. Claims 1-14 remain pending.

In the Office Action of September 5, 2002, the Examiner rejected claims 1-14 under 35 U.S.C. § 103(a) as unpatentable over Mano et al. (U.S. Patent No. 5,319,700) in view of Best et al. (U.S. Patent No. 6,005,846). Because the Examiner has not stated a *prima facie* case of obviousness, Applicant respectfully traverses the rejection for the following reasons.

To establish a proper *prima facie* case of obviousness under 35 U.S.C. § 103(a), each of three requirements must be met. First, the reference or references, taken alone or combined, must teach or suggest each and every element recited in the claims. See M.P.E.P. § 2143.03 (8th ed. 2001). Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available

to one of ordinary skill in the art, to combine the references in a manner resulting in the claimed invention. See M.P.E.P. § 2143.01 (8th ed. 2001). Third, a reasonable expectation of success must exist. See M.P.E.P. § 2143.02 (8th ed. 2001). Moreover, each of these requirements must “be found in the prior art, and not be based on applicant’s disclosure.” M.P.E.P. § 2143 (8th ed. 2001).

Applicant’s independent claim 1 includes, among other things, “a first transmitter configured to transmit a type query signal to the telephone terminal at a first speed” and “a second transmitter configured to transmit a speed change request to the telephone terminal and change a transmission speed to a second speed if the received type signal indicates that the telephone terminal is capable of transmitting data at the second speed.” By contrast, Mano discloses a terminal adapter pooling system for reducing the load applied to a central control unit at the calling party signal transmission and the called party number signal reception. Mano does not teach or suggest at least these exemplary elements of independent claim 1.

Furthermore, the Examiner admits Mano does not disclose all of the elements of the present invention. Specifically, the Examiner admits Mano “does not explicitly show using a query signal to determine the type of communication speed required for communication and changing the transmission speed based upon the type of communication speed required” (Office Action, page 2).

Moreover, Best does not make up for the deficiencies of Mano. To the contrary, Best discloses an ISDN terminal adapter that provides automatic ISDN switch detection, automatic SPID (service profile identification) configuration, baud rate unblocking, and automatic data compression. The terminal adapter disclosed in Best automatically

detects the switch type by analyzing D-channel ISDN initialization messages and sets the switch type accordingly (col. 4, lines 28-36). Additionally, the switch type value is used to access an internal database table of predefined SPID formats (col. 4, lines 37-42). Best fails to disclose or suggest at least the exemplary features of independent claim 1 noted above in the discussion of the shortcomings of Mano. Accordingly, any reasonable combination of Mano and Best fails to teach or suggest at least these exemplary features of independent claim 1.

The Examiner also alleges that Best discloses "when a subscriber moves a conventional ISDN terminal that was present either by the factory or the subscriber to a predefined baud rate, the terminal adaptor and computer will not communicate until baud rates match (columns 1-4)" (Office Action, page 3). Applicant respectfully submits that the Examiner has not made up for the deficiencies of Mano with Best with this allegation for the following reasons.

Specifically, neither Mano, nor Best, in any reasonable combination, disclose or suggest at least "a first transmitter configured to transmit a type query signal to the telephone terminal at a first speed" and "a second transmitter configured to transmit a speed change request to the telephone terminal and change a transmission speed to a second speed if the received type signal indicates that the telephone terminal is capable of transmitting data at the second speed," as recited in independent claim 1.

Furthermore, the Examiner also alleges "it would have been obvious for any one of ordinary skill in the art at the time the invention was made to modify the invention as taught by Mano to use an improved adapter using the D-channel for "autobaud" capability as taught by Best for the benefit of automatically setting transmission rate"

(Office Action, page 3). Such an allegation by the Examiner is unsubstantiated by any factual evidence in the record, such as a competent prior art reference. In the absence of such a prior art reference, a *prima facie* case of obviousness has not been made and the Examiner should withdraw the rejection of independent claim 1 for at least this reason.

Mano discloses a terminal adapter pooling system for reducing the load applied to a central control unit at the calling party signal transmission and the called party number signal reception. Best discloses an ISDN terminal adapter that provides automatic ISDN switch detection, automatic SPID (service profile identification) configuration, baud rate unblocking, and automatic data compression. These references are thus directed toward different goals. Furthermore, the Examiner's characterization of Mano and Best fails to establish that there would have been the requisite suggestion or motivation to modify either reference to produce Applicant's claimed invention.

Specifically, Applicant respectfully points out to the Examiner it "is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art." See In re Wesslau, 147 U.S.P.Q. 391 (C.C.P.A. 1965). See *also* M.P.E.P. § 2141.02, p. 2100-120. By contrast, the required motivation to combine references must "be found in the prior art, and not based on applicant's disclosure." See M.P.E.P. § 2143 (emphasis added).

In that regard, the present invention, as recited in independent claim 1, cannot be attained based merely on the combination of Mano and Best. One skilled in the art would only arrive at the present claimed invention by consulting Applicant's disclosure. In particular, the only way to construct the claimed invention from the cited references would be to rely on aspects related to the present invention. Such reliance, however, would constitute improper hindsight reasoning. Thus, Applicants submit that Mano and Best, taken alone or in combination, do not suggest the desirability of any modification to result in Applicant's claimed invention, and these references do not show that there would be any reasonable expectation of success from so doing.

Furthermore, there is no suggestion or motivation to modify Mano with Best to produce Applicant's claimed invention, and such combination would not be appropriate or effective. Even the Examiner's erroneous characterization of Mano and Best does not establish that there would have been the requisite suggestion or motivation to modify Mano with Best. "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." M.P.E.P. § 2143.01, p. 2100-124, *citing In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

Additionally, the Examiner's rejection of independent claims 5, 9-10, 12, and 14 uses the same rationale as the Examiner's rejection of independent claim 1. Independent claims 5, 9-10, 12, and 14 are of a similar scope as claim 1. For example, independent claim 5 includes at least "a second transmitter configured to transmit a speed change request to the telephone terminal and change a transmission speed to a second speed if the received type signal indicating that the telephone terminal is

capable of transmitting data at the second speed"; independent claim 9 includes at least "causing the interface unit to transmit a speed change request to the telephone terminal and change a transmission speed to a second speed if the received type signal indicates that the telephone terminal is capable of transmitting at the second speed," independent claims 10 and 12 include at least "a detector configured to detect whether or not the telephone terminal is capable of transmitting and receiving data at the second speed"; and independent claim 14 includes at least "a transmitter configured to transmit a type signal to the main unit at a first speed in response to a type query signal transmitted from the main unit at the first speed."

For at least the same reasons as discussed above regarding independent claim 1, Mano and Best, either singularly, or in combination, fail to teach or suggest at least these exemplary features of independent claims 5, 9-10, 12, and 14. Accordingly, the Examiner should withdraw the rejection of independent claims 1, 5, 9-10, 12, and 14 for at least this reason.

Each of dependent claims 2-4, 6-8, 11, and 13 depend from allowable independent claims 1, 5, 9-10, 12, and 14, and are at least allowable with respect to the discussion above regarding the independent claims. These dependent claims disclose additional features that are neither suggested nor disclosed by Mano nor Best, either individually, or in any reasonable combination. Thus, for at least this reason, the Examiner should withdraw the rejection of claims 2-4, 6-8, 11, and 13.

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CONCLUSION

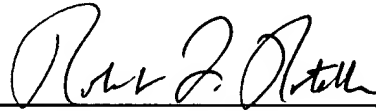
In view of the foregoing remarks, Applicant respectfully requests the reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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APPENDIX TO AMENDMENT OF DECEMBER 2, 2002
VERSION WITH MARKINGS TO SHOW CHANGES MADE

AMENDMENTS TO THE CLAIMS

1. (AMENDED) An interface unit capable of being connected to a main unit of a key telephone system, the main unit connecting a telephone terminal to a telephone network, the interface unit [being] adapted to [be communicated] communicate with the telephone terminal at one of plural transmission speeds, the interface unit comprising:

a first transmitter configured to transmit a type query signal to the telephone terminal at a first speed;

a first receiver configured to receive a type signal from the telephone terminal at the first speed; and

a second transmitter configured to transmit a speed change request to the telephone terminal and change a transmission speed to a second speed if the received type signal [indicating] indicates that the telephone terminal is capable of transmitting data at the second speed.

5. (AMENDED) A key telephone system comprising a telephone terminal and a main unit which connects the telephone terminal to a telephone network, and includes a telephone interface unit connected to the telephone terminal, a network

interface unit connected to a telephone network, and a connection line connecting the telephone interface unit and the network interface unit, wherein

said telephone interface unit comprising:

a first transmitter configured to transmit a type query signal to the telephone terminal at a first speed;

a first receiver configured to receive a type signal from the telephone terminal at the first speed; and

a second transmitter configured to transmit a speed change request to the telephone terminal and change a transmission speed to a second speed if the received type signal [indicating] indicates that the telephone terminal is capable of transmitting data at the second speed, and

said telephone terminal comprising:

a first transmitter configured to transmit the type signal to the interface unit at the first speed in response to the type query signal; and

a first receiver configured to receive the speed change request transmitted from said second transmitter and to change a transmission speed to the second speed in response to the receiver speed change request.

10. (AMENDED) An interface unit for a telephone system comprising a telephone terminal and a main unit which connects the telephone terminal to a telephone network and includes the interface unit capable of being connecting to the telephone terminal, the telephone terminal being capable of operating at one of a first

speed and a second speed which is faster than the first speed, the interface unit comprising:

a transmitter configured to transmit data to the telephone terminal at one of the first speed and the second speed;

a receiver configured to receive data from the telephone terminal at one of the first speed and the second speed;

a detector configured to detect whether or not the telephone terminal is capable of [transmit and receive] transmitting and receiving data at the second speed; and

a mode setting device configured to set an operation speed of said transmitter and said receiver to an optimum speed based on the detection result of said detector.

12. (AMENDED) A main unit connecting a telephone terminal to a telephone network, comprising:

a transmitter configured to transmit data to the telephone terminal at one of the first speed and the second speed;

a receiver configured to receive data from the telephone terminal at one of the first speed and the second speed;

a detector configured to detect whether or not the telephone terminal is capable of [transmit and receiver] transmitting and receiving data at the second speed; and

a mode setting device configured to set an operation speed of said transmitter and said receiver to an optimum speed based on the detection result of said detector.